

Attorney Docket No.: ISPH-0567  
Inventors: Bennett et al.  
Serial No.: 09/938,048  
Filing Date: August 23, 2001  
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#### REMARKS

Claims 1-29 are pending in the instant application. Claims 12-29 have been withdrawn from consideration. Claims 1-11 have been rejected. Applicants believe that the Examiner has made an error and meant to withdraw claims 15-29 from consideration as those are the claims that do not belong to the elected invention of Group I. Accordingly, claims 3, 9 and 15-29 have been canceled. Claims 1, 4, 5, 7, 10 and 11 have been amended. No new matter has been added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

#### I. Election/Restriction

The Restriction Requirement wherein Applicants have elected Group I, claims 1-14 and the species "modulation of inflammation", has been deemed proper and made final. Accordingly, claims 15-29 have been canceled, with Applicants reserving the right to file continuing applications on the canceled subject matter. As pointed out above, Applicants believe the Examiner has made an error in the Office Action and meant to withdraw only claims 15-29 from consideration, as claims 1-14 had been placed by the Examiner into Group I, the elected subject matter.

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## II. Rejection of Claims Under 35 U.S.C. 112, Second Paragraph

Claims 3 and 4 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner suggests that claim 3 recites "wherein said compound is" and there is insufficient antecedent basis for this term, leaving claims 3 and 4 vague and indefinite. Applicants have canceled claim 3 and amended claim 4 to correct the antecedent basis for the claim. Withdrawal of this rejection is respectfully requested.

## III. Rejection of Claims Under 35 U.S.C. 102(b)

Claims 1, 2, 5, 6 and 9-11 have been rejected under 35 U.S.C. 102(b) as being anticipated by Baker et al. (US Patent 6,080,580). The Examiner suggests that this patent discloses use of an antisense library targeted to TNF- $\alpha$ , a cytokine, which is involved in inflammatory responses, including adding these antisense oligonucleotides to cells and measuring expression of the TNF- $\alpha$  gene following such treatment. Applicants respectfully disagree with the Examiner's conclusions.

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Baker et al. (US Patent 6,080,580) disclose the use of antisense compounds targeted to TNF- $\alpha$  for inhibition of expression of this gene in cells in vitro. Nowhere does this patent, however, teach a method for identifying a gene involved in a response such as claimed in the instant invention. The present method specifies contacting cells, tissues or organisms that are capable of exhibiting an inflammatory response after a stimulus has been applied with a library of antisense oligonucleotides prior to treatment with a stimulus, and then determining which antisense oligonucleotides modulate the inflammatory response wherein the antisense oligonucleotides that modulate the response correspond to genes involved in inflammation. Nowhere does the patent of Baker et al. teach a method where the goal is to identify a gene. In this patent, the gene is used to design oligonucleotides, the oligonucleotides are not used to identify a gene. Accordingly, this patent teaches a different method from the method of the instant invention, failing to teach the limitations of the claims, and cannot anticipate the claimed invention. Withdrawal of this rejection is therefore respectfully requested.

Claims 1, 2, 7, 8 and 9-11 have been rejected under 35 U.S.C. 102(b) as being anticipated by Bennett et al. (US Patent 5,514,788). The Examiner suggests that this patent discloses use

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of antisense targeted to various cell adhesion molecules that are involved in inflammation, specifically ICAM, VCAM and ELAM. The Examiner suggests that this patent discloses inhibition of these adhesion proteins with antisense oligonucleotides from antisense libraries as well as measurement of levels of gene expression in cells after treatment of the cells with antisense and prior to challenge of the cells with various cytokines. Applicants respectfully disagree with the Examiner's conclusions.

Bennett et al. (US Patent 5,514,788) disclose the use of antisense compounds targeted to ICAM, ELAM or VCAM for inhibition of expression of the genes encoding each of these cell adhesion molecules in cells *in vitro*. Nowhere does this patent, however, teach a method for identifying a gene involved in a response such as claimed in the instant invention. The present method specifies contacting cells, tissues or organisms that are capable of exhibiting an inflammatory response after a stimulus has been applied with a library of antisense oligonucleotides prior to treatment with a stimulus, and then determining which antisense oligonucleotides modulate the inflammatory response wherein the antisense oligonucleotides that modulate the response correspond to genes involved in inflammation. Nowhere does the patent of Baker et al. teach a method where the goal is to identify a gene. In

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this patent, the gene is used to design oligonucleotides, the oligonucleotides are not used to identify a gene. Accordingly, this patent teaches a different method from the method of the instant invention, failing to teach the limitations of the claims, and cannot anticipate the claimed invention. Withdrawal of this rejection is therefore respectfully requested.

#### IV. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

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